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10/786,622	02/24/2004	Kazumasa Inoue	TKMTP127	2045
22434	7590	04/16/2008		
BEYER WEAVER LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			EXAMINER CHEUNG, WILLIAM K	
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			1796	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/786,622

**Applicant(s)**

INOUE ET AL.

**Examiner**

WILLIAM K. CHEUNG

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/29/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 10 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### DETAILED ACTION

1. In view of amendment filed January 29, 2008, claims 1, 10, 12-17 are pending. Claims 12-17 are drawn to non-elected subject matter. Claims 1, 10 are examined with merit.
2. In view of the amendment and argument filed January 29, 2008, the rejection of Claims 1, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerkar et al. (US patent 5,604,273) in view of Ohta et al. (US Patent 5,660,626), further in view of Berke et al. (US Patent 5,571,319), and yet, still further in view of Kloetzer et al. (US Patent 4,927,463), is withdrawn.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

An improper use of MARKUSH GROUPS is recited in claim 1 (line 5-6), The term "selected from ... and ..." is improper. It should be corrected to "selected from a group consisting of ....., and ...." See MPEP 2173.05 (h).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerkar et al. (US patent 5,604,273) in view of Ohta et al. (US Patent 5,660,626), further in view of Fischer (US Patent 3,287,145), and yet, still further in view of Kloetzer et al. (US Patent 4,927,463) for the reasons adequately set forth from paragraph 4 of the office action of November 1, 2007.

Claim 1 (currently amended): A multi-functional admixture for concrete, said multi-functional admixture comprising Component A by 20-84 weight %, Component B by 15-79 weight % and Component C by 0.3-3 weight % such that their total will be 100 weight %, wherein:

said Component A is one or more copolymers selected from ~~the group consisting of~~ graft copolymers and salts of copolymers, wherein the graft copolymers are obtained by a first process and a second process, and the salts of graft copolymers are obtained by said first process, said second process and a third process;

said first process is for obtaining copolymers with weight-average molecular weight of 10000-50000 by radical polymerization of a mixture of radical polymerizable monomers containing maleic anhydrides and monomers shown by Formula 1 by a total of 95 molar % or more at molar ratio of 50/50-70/30 in the absence of solvent;

said second process is for obtaining graft copolymers by graft reaction of 100 weight parts of said copolymers obtained in said first process with 0.2-4 weight parts of polyether compounds shown by Formula 2;

said third process is for obtaining salts of graft copolymers by partially or completely neutralizing said graft copolymers obtained in said second process with alkali metal hydroxide;

said Component B is polypropyleneglycol monoalkyl ether shown by Formula 3;

said Component C is organic phosphate shown by Formula 4 or Formula 5;

Formula 1 is given by  $\text{CH}_2=\text{CH}-\text{CH}_2-\text{O}-\text{A}^1-\text{O}-\text{R}^1$ ;

Formula 2 is given by  $\text{R}^2-\text{O}-\text{A}^2-\text{OH}$ ;

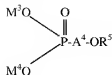
Formula 3 is given by  $\text{R}^3-\text{O}-\text{A}^3-\text{OH}$ ;

Formula 4 is given by



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Formula 5 is given by



where:

 $\text{R}^1$  is methyl group or acetyl group; $\text{R}^2$  is aliphatic hydrocarbon group with 10-20 carbon atoms; $\text{A}^1$  is residual group obtained by removing all hydroxyl groups from polyethyleneglycol with polyoxyethylene group having 10-90 oxyethylene units in molecule; $\text{A}^2$  is residual group obtained by removing all hydroxyl groups from polyalkyleneglycol with polyoxyalkylene group having in molecule a total of 25-60 oxyethylene units and oxypropylene units; $\text{R}^3$  is alkyl group with 3-5 carbon atoms; $\text{A}^3$  is residual group obtained by removing all hydroxyl groups from (poly)propyleneglycol with (poly)oxypropylene group having in molecule only 2-4 oxypropylene units; $\text{R}^4$  and  $\text{R}^5$  are each alkyl group with 8-18 carbon atoms; $\text{A}^4$  is (poly)oxypropylene group with 1-5 oxypropylene units; $\text{M}^1$ ,  $\text{M}^2$ ,  $\text{M}^3$  and  $\text{M}^4$  are each hydrogen atom, alkali metal, alkali earth metal, ammonium or organic amine.

The prior art to Kerker et al. directs to a cement admixture composition comprising a alkenyl ether/maleic copolymer which is represented by the formula shown at column 3, lines 15-31, which reads on the instant claimed first process in making the component A. Kerker et al. disclose that the number average molecular weight of the copolymer is preferably 1,000 to 200,000 (column 3, lines 54-57). Kerker et al. also teach that the salt of the hydrolyzed product of the copolymer is a salt formed by the maleic acid unit. Exemplary salts include alkali metal salts and alkaline earth metal salts (column 3, lines 61-67), which reads on the instantly claimed third process.

The difference between the prior art and the present application is that Kerkar et al. do not include the second process as required by the instant claim 1. Kerkar et al. do not include components B and C in the admixture formulation.

However, Kerkar et al. disclose that the component (n), i.e. the maleic acid unit in the formula III, can be present in the form of the anhydride, or a partially or completely hydrolyzed product or as a salt of the hydrolyzed product (column 3, lines 32-34) and the hydrolyzed product is a product having a hydrolyzed maleic acid unit resulting from the hydrolysis of the maleic anhydride unit in the copolymer (column 3, lines 59-60). This disclosure would give a hint of exploring a further process for the graft copolymer to one having ordinary skill in the art.

The prior art to Ohta et al. relates to a shrinkage-reducing dispersion for use in cementitious compositions comprising a graft polymer, which is a polycarboxylic acid or a salt thereof, having side chains derived from oligoalkyleneglycol (Abstract). "—CH(CO(OM))—CH(CO(OR))—" unit is recognized in General Formulas S, A and B (columns 5-6) wherein M is H and R is oligoalkyleneglycol (column 5, line 51 and column 6, line 1, and also column 2, lines 10-19).

In light of Ohta et als' teaching of obtaining a graft polymer with said side chains through hydrolysis of the maleic anhydride unit, it would have been obvious to one having ordinary skill in the art at the time the invention was made to hydrolyze the maleic anhydride unit in Kerkar et als' copolymer, as taught by Ohta et al., because Kerkar et al. expressively imply hydrolysis of the maleic acid unit and Ohta et al. teach

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that the graft polymer having the said chain obtained through such hydrolysis provides shrinkage-reducing in cementitious composition (Abstract).

As to the component B, the prior art to Fischer directs to a storage stable cement admixture comprising alkylated polyalkylene glycol (column 3, lines 34-46). Motivated by the expectation of success of improving the setting and hardening properties (col. 1, line 15-19), it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate alkylated alkylene glycol, as taught by Berke et al., in Kerkar et als' admixture.

As to the component C, the prior art to Kloetzer et al. provides a stabilized aqueous dispersion comprising gypsum and a surface-active which is a phosphoric acid esters represented by formula I or II (Abstract, column 2, lines 61-68, and column 3, lines 10-31), wherein the formula II meets the instant claimed component C of formula 5. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a phosphoric acid ester surfactant, as taught by Kloetzer et al., in Kerkar et als' admixture motivated by a reasonable expectation of successfully obtaining the corresponding admixture for concrete since Kloetzer et al. have taught the benefits of increased storage stability by incorporating such phosphoric acid ester surfactant in a gypsum admixture.

In regard to claim 2, Kerkar et al. teach that a cement admixture composition should contain the copolymer in a weight ratio of 1-100 (column 4, lines 40-42); Berke et al teach that a cement admixture composition can contain up to 35 wt% of the glycol



(column 7, lines 38-40); Kloetzer et al. disclose that phosphoric acid ester is present in an amount of 0.1-2 wt% of the aqueous dispersion composition (column 7, lines 31-33).

In regard to claim 3, Kerkar et al. require the number average molecular weight for the copolymer to be 1,000 to 200,000 (column 3, lines 54-57).

As to claims 4-9, the rejection made to Claim 1 described previously in this Office Action would be applied herein to reject Claims 4-9.

As to claims 10-11, Kloetzer et al. disclose that the dispersions are normally adjusted to a pH value of 9-10 when an aqueous solution of alkali metal hydroxide is used (column 4, lines 50-57). Such pH adjustment would result in a phosphoric acid ester of formula II (column 3, line 20) wherein -OH would become -OM (M=alkali metal).

### ***Response to Arguments***

7. Applicant's arguments filed January 29, 2008 have been fully considered but they are not persuasive.

Regarding applicants' admission that there is a partial overlap between Component C and what is described in Kloetzer et al., applicants must recognize then the Kloetzer et al. is adequate for the rejection set forth.

Regarding the "unexpected results" in the Declaration filed January 29, 2008, in an attempt to show the criticality of the claimed overlap region, applicants fail to recognize that the use of comparative data to show the criticality of the claimed range, applicants must show that the disclosed overlap range is not desirable in the prior art.

Since applicants' comparative data fail to show the criticality of the claimed range, the rejection set forth is proper. Applicants must also recognize that the data presented shows all the samples have substantially identical or similar properties or performances within experimental error. Therefore, the comparative data filed fail to demonstrate the criticality of the claimed invention.

### ***Priority***

8. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on March 3, 2003. It is noted, however, that applicant has not filed a certified copy of the 2003-55175 application as required by 35 U.S.C. 119(b).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William K Cheung/  
Primary Examiner, Art Unit 1796

William K. Cheung, Ph. D.

Primary Examiner

April 14, 2008

